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Milton J Wayne  
Burgess Ryan and Wayne  
Suite 2105  
370 Lexington Avenue  
New York, NY 10017

EXAMINER

ZURITA, JAMES H

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 03/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/730,256

Applicant(s)

OBA, SHIGEHITO

Examiner

James H Zurita

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 December 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Priority***

If applicant desires priority under 35 U.S.C. 119(e) based upon a previously filed application, specific reference to the earlier filed application must be made in the instant application. For benefit claims under 35 U.S.C. 120, 121 or 365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of the applications. This should appear as the first sentence of the specification following the title, preferably as a separate paragraph unless it appears in an application data sheet. The status of nonprovisional parent application(s) (whether patented or abandoned) should also be included. If a parent application has become a patent, the expression "now Patent No. \_\_\_\_" should follow the filing date of the parent application. If a parent application has become abandoned, the expression "now abandoned" should follow the filing date of the parent application.

If the application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the

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prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A priority claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed claim for priority under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

### ***Drawings***

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: in Figs. 1 and 2, method steps claimed in the various claims.

**Fig. 1 and Fig. 2** contradict each other. Both figures show a decision block [missing a reference number] with the text "Customer Xi already communicated

regarding chosen thank-you gift?" If the answer is "yes", both figures show that a process ends. However, both figures show that a "no" leads to different results.

Fig. 2 refers to a "...customer information administrator..." Fig. 3 refers to a "...thank-you gift information administrator..." The various claims refer to "...thank-you information administrator..."

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. For example, Claims 2 and 4 contain the step of making an enquiry, which is not found in the figures. Therefore, the enquiry step must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

**Claims 2 and 4** are objected to because of the following informalities:

**Claim 2** refers to an "...administrator..." Claim 4 refers to an "...administrator..." and a "...thank-you administrator..." All other claims refer to a "...thank-you information administrator..." while Fig. 2 refers to a "...customer information administrator..." and Fig. 3 refers to a "...thank-you gift information administrator..." These differences appear to be the result of word processing errors. For purposes of this examination, the examiner will interpret claims 2 and 4 to refer to "thank-you information administrator" as in other claims.

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**Claim 4** states "...and dispatching a thank-you gift *chosen* by said thank-you (information) administrator to the customer based on an output signal from a computer." This appears to state that the administrator chooses a thank-you gift, rather than a customer.

**Claims 1-14** are directed to a "...order/dispatch..." The slash "/" renders the claim indefinite. The slash "/" is not defined by the disclosures. For purposes of this examination, the Examiner will interpret the claims to be directed to a "...order and dispatch..." method.

Correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claim 1** contains the term "directly", a relative term which renders the claim indefinite. The term "directly" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

**Claims 2, 4 and 5** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

**Claim 2** reads:

2. (Amended) The thank-you gift order/dispatch method of claim 1, further comprising the steps of:

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a storing information regarding at least addresses and names of the customers in a computer memory in advance by said thank-you gift information administrator, and

b (administrator?) making an enquiry to the customer by the (thank-you gift information?) administrator in the event that a customer fails to communicate regarding at least one of the name and number of a chosen thank-you gift even after a predetermined period of time, based on an output signal from a computer, regarding whether the customer intends to receive a thank-you gift or not and at least one of the name and number of a chosen thank-you gift if the customer intends to receive the-thank-you gift.

From the phrase "...and at least one of the name and number of a chosen thank-you gift if the customer intends to receive the-thank-you gift..." it is not clear whether the administrator has the information before making the enquiry or whether the customer provides the administrator with the information. From the term "...regarding whether the customer intends to receive a thank-you gift or not and (if the customer intends to receive the gift ??) at least one of the name and number of a chosen thank-you gift..." it is not clear what happens if the customer does not intend to receive the gift or if the customer intends to not receive the gift.

**Claim 4**, step 3 refers to "...dispatching a thank-you gift chosen by said thank-you (gift information?) administrator to the customer based on an output signal from a computer..." The disclosures state that items are sent by a dispatch agent, after the dispatch agent receives instructions from the administrator. In addition, the disclosures state that dispatching agents (manufacturers or wholesalers) may be regional and may provide different types of gifts.

**Claims 2 and 4** refer to "...storing...address and name...in advance..." This action takes place in a precursor step that is not positively recited and is outside the metes and bounds of claims 2 and 4.

**Claim 5** recites a step of "...stopping the administrative process regarding the customer, by said thank-you gift information administrator in the event that the customer still fails to reply within a further certain period since dispatch of the thank-you gift chosen by said thank-you gift information administrator from a thank-you gift dispatch agent..." The claim recites a condition where a gift was dispatched to a customer by an agent on the instructions of the administrator. Since processing ends when the customer is sent a gift as described, it is not clear what time period is running and what administrative process is being stopped.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claim 1** is rejected under 35 U.S.C. 101 because the claimed invention the disclosed invention is inoperative and therefore lacks utility. Gifts are dispatched to customers by agent(s) upon notification by an administrator. There is no name and address information collected for customers in claim 1. It is not clear how a gift gets to a customer, since the customer name and address information is acquired and stored only in claim 2. Applicant may overcome this rejection by moving the step of storing customer information (name and address) to claim 1, prior to the dispatch step.

**Claim 1** is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 1 provides for several steps that do not



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recite the use of technology; the steps may be performed without the use of technology. For example "...first, distributing books of thank-you gifts to customers attending an event..." reveals that the books are physically distributed by hand to customers at an event. The second step, whereby "...customers notify a thank-you gift information administrator of at least one of names and numbers assigned to chosen thank-you gifts, via one of the following ways: a) through a management of a site of the event, and b) directly..." The third step, "...having the thank-you gift information administrator give an instruction to a thank-you gift dispatch agent based on at least one of the names and numbers of said chosen thank-you gifts so that said chosen thank-you gifts are dispatched to the customers..."

**Claim 4** is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 4 refers to "...making an enquiry to the customer by the (thank-you gift information) administrator in the event that a customer fails to communicate regarding at least one of a name and number of a chosen thank-you gift even after a predetermined period of time..." and does not include technology. The disclosures reveal that the enquiry is performed by mailing a postcard.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jack et al., US Patent 5,915,244.

Claims 1-14 are interpreted in view of the rejections under 35 USC § 112 and 35 USC § 101, above. The claims are treated as best understood and treated in light of the disclosures.

**As per claim 1**, Jack discloses methods, comprising the steps of:

- a) distributing catalogs of awards to customers (applicant's "...books of thank-you gifts..."). See, for example, at least Col. 6, lines 49-57.
- b) customers notify a administrator of at least one of names and numbers assigned to chosen gifts, via one of the following ways: a) through a management of a site of the event, and b) directly. Customers notify an administrative center (applicant's administrator). See, for example, at least Col. 11, lines 24-37. See also references to administering incentive programs, at least Col. 1, line 37-Col. 2, line 3. See references to administering incentive programs, at least Col. 1, line 37-Col. 2, line 3. To choose a gift, customers may speak to customer representatives, who acts as agent of the administrator. See, for example, Fig. 4, item 74 and related text. Customers may also choose their gifts automatically with the administrative computer. See, for example, Fig. 4, item 78 and related text.
- c) administrator give an instruction to redemption centers (applicant's thank-you gift dispatch agent) based on at least one of the names and numbers of said chosen gifts so that the chosen gifts are dispatched to the customers. Customers select their gifts based on at least one of the names and numbers of said gifts. See, for example,

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references to item number of a desired gift, Col. 11, lines 23-37. The administration center selects the gift from inventory (item 84) and processes the order (see at least Fig. 4, item 92). Redemption centers dispatch awards to customers. See, for example, Fig. 4 and related text, Col. 8, line 28-Col. 9, line 18. See also at least references to shipping of goods, for example, Col. 11, lines 37-53, Fig. 11, item 170, Fig. 4, item 94.

**As per claim 1**, Jack **does not** specifically disclose that the method is a “thank-you gift order/dispatch” method where the steps include.

- a) ...first ... of thank-you ... attending an event,
- b) then having the ... a thank-you gift information ... of at least one of names and numbers assigned to chosen thank-you gifts, via one of the following ways: a) through a management of a site of the event, and b) directly,
- c) having the thank-you gift information ...to a thank-you gift dispatch ... based on at least one of the names and numbers of said chosen thank-you gifts so that said chosen thank-you ... to the customers.

However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The steps of distributing, notifying and dispatching would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to disclose

- a) ...first ... of thank-you ... attending an event,
- b) then having the ... a thank-you gift information ... of at least one of names and numbers assigned to chosen thank-you gifts, via one of the following ways: a) through a management of a site of the event, and b) directly,
- c) having the thank-you gift information ...to a thank-you gift dispatch ... based on at least one of the names and numbers of said chosen thank-you gifts so that said chosen thank-you ... to the customers.

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because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

**As per claim 2**, Jack discloses methods and steps for

(a) storing information regarding at least addresses and names of the customers in a computer memory. See, for example, at least Col. 7, line 60-Col. 8, line 4. Jack discloses that the administrator, after predetermined periods of time and based on computer reports (applicant's output signals from a computer), identifies customers who have not ordered their gifts. See, for example, references to reports concerning unused credits, at least Col. 1, line 36-Col. 2, line 44.

(b) making an enquiry to the customer by the administrator in the event that a customer fails to communicate regarding at least one of a name and number of a chosen gift even after a predetermined period of time. See, for example, at least Col. 5, lines 25-33, which show that when programs are over, administrative personnel may ask customers to obtain a gift.

**Claim 2** refers to "...storing...address and name...in advance...". For purposes of this examination, this language is interpreted as nonfunctional descriptive material since the action takes place in precursor step(s) that are not positively recited and are outside the metes and bounds of claims 2 and 4. Thus, this nonfunctional descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

**As per claim 2**, Jack **does not** specifically disclose that the method is a "thank-you gift order/dispatch" method where the steps include

- a) ... in advance by said thank-you gift information administrator, and
- b) ... (thank-you gift information) ... in the event that a customer fails to communicate regarding at least one of the name and number of a chosen thank-you gift even ... regarding ... a thank-you ... or not and [if the customer intends to receive the gift] ... thank-you ...

However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The steps of storing and making an enquiry would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to disclose

- a) ... in advance by said thank-you gift information administrator, and
- b) ... (thank-you gift information) ... in the event that a customer fails to communicate regarding at least one of the name and number of a chosen thank-you gift even ... regarding ... a thank-you ... or not and [if the customer intends to receive the gift] ... thank-you ...

because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

**As per claim 3**, Jack discloses stopping the administrative process regarding the customer, by said administrator if the customer still fails to reply within a certain period. Programs have start and finish dates. See, for example, Col. 4, lines 43-55. At the end

of the program period, administrators may stop the program by closing each customer's account. See, for example, Col. 4, lines 26-41.

**As per claim 4, Jack discloses**

(a) storing information regarding at least addresses and names of customers in a computer memory. See, for example, at least Col. 7, line 60-Col. 8, line 4.

(b) making an enquiry to the customer by the administrator in the event that a customer fails to communicate regarding at least one of a name and number of a chosen gift even after a predetermined period of time. See, for example, at least Col. 5, lines 25-33, which show that when programs are over, administrative personnel may ask customers to obtain a gift.

(c) dispatching a gift by an administrator to the customer based on an output signal from a computer. See at least references to shipping of goods, for example, Col. 11, lines 37-53, Fig. 11, item 170, Fig. 4, item 94. For administrator, see references to administering incentive programs, at least Col. 1, line 37-Col. 2, line 3. See references to customers calling a customer representative, who is an agent of the administrator. Customers may speak to customer representatives (see, for example, Fig. 4, item 74 and related text. Customers may also place their orders automatically. Information is then sent to redemption centers that are responsible for sending the gifts to customers. See references to redemption centers, at least Col. 8, line 41-Col. 9, line 10.

**Claim 4** refers to "...storing...address and name...in advance...". For purposes of this examination, this language is interpreted as nonfunctional descriptive material since the action takes place in precursor step(s) that are not positively recited and are

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outside the metes and bounds of claims 2 and 4. Thus, this nonfunctional descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

**As per claim 4**, Jack **does not** specifically disclose that the method is a "thank-you gift order/dispatch" method where the steps include:

- a ... in advance by a thank-you gift information ...,
- b ... thank-you gift information ... in the event that a customer fails to communicate regarding at least one of a name and number of a chosen thank-you gift even ..., and
- c ...chosen by said thank-you (gift information) administrator to the customer based on an output signal from a computer.

However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The steps of storing, making an enquiry and dispatching a gift would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Further, the act of having gift "...chosen by said thank-you (gift information) administrator to the customer based on an output signal from a computer...." is carried out in a method step that is implied but not positively recited.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to disclose

- a ... in advance by a thank-you gift information ...,
- b ... thank-you gift information ... in the event that a customer fails to communicate regarding at least one of a name and number of a chosen thank-you gift even ..., and
- c ...chosen by said thank-you (gift information) administrator to the customer based on an output signal from a computer.

because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

**As per claim 5**, Jack discloses that when customers fail to reply and select a gift within specified periods, the administrator may stop the administrative process regarding the customer. See, for example, references to unused credits, at least in Col. 2, Lines 32-58 and Col. 11, lines 24-64. Jack **does not** specifically disclose that such actions occur after "...a further certain period since dispatch of the gift chosen by said administrator from a agent...."

However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The step of stopping the administrative process would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). As noted with respect to claim 4, the act of having gift "...chosen by said thank-you (gift information) administrator to the customer based on an output signal from a computer...." Is carried out in a method step that is implied but not positively recited and is treated as nonfunctional descriptive material.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to disclose

- a ... in advance by a thank-you gift information ...,
- b ... thank-you gift information ... in the event that a customer fails to communicate regarding at least one of a name and number of a chosen thank-you gift even ..., and



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c ...chosen by said thank-you (gift information) administrator to the customer based on an output signal from a computer.

because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

**As per claims 6 and 9**, Jack discloses that catalogs to be distributed are different from each other in terms of one of prices of the gifts and price ranges of the gifts. See, for example, references to price ranges, at least Col. 5, line 1-Col. 7, line 17.

**As per claims 7, 10 and 13**, Jack **does not** specifically disclose that remote redemption centers (applicant's thank-you gift dispatch agents) may be classified by region. Jack discloses that gifts may be shipped to customers at various locations from remote redemption centers. See, for example, at least Fig. 6 and related text. Fig. 6 shows that gifts may be shipped to various states and countries. Jack also discloses particular instructions to warehouses and delivering carriers. Jack discloses that the system calculates shipping costs and incorporates them into the price ranges and plateau pricing for the catalog gifts. Jack also discloses that customers may call the toll-free number of a remote redemption center responsible for mailing awards to participants. It would have been obvious to one of ordinary skill in the art at the time the invention was made to extend Jack to disclose classifying remote redemption centers (applicant's thank-you gift dispatch agents) by region. One of ordinary skill in the art at the time the invention was made would have been motivated to extend Jack to disclose classifying remote redemption centers (applicant's thank-you gift dispatch agents) by

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région for the obvious reason that by doing so, the total cost of a gift program may be reduced. This permits the gift-giver to reduce his overall costs and allow the gift-giver to provide recipients with gifts that are more expensive or of better quality. Recipients may feel more appreciated and loved if they see that they could receive better-quality, more tasteful gifts.

**As per claims 8, 11 and 14**, Jack **does not** specifically disclose providing remote redemption centers (applicant's thank-you gift dispatch agents) which are different from each other in accordance with the types of gifts. Jack discloses that catalogs to be distributed are different from each other in terms of one of prices of the gifts and price ranges of the gifts. See, for example, references to price ranges, at least Col. 5, line 1-Col. 7, line 17. Jack also discloses that employees may be given gifts according to their performance. For example, see at least references to salesmen and quotas, at least Col. 7, lines 20-39. It is well known that in groups, some individuals may have more prestige than others. In the businesses disclosed by Jack, for example, some employees might be janitors. Other employees might be attorneys, or corporate officers, such as presidents and chairmen of the board. Gifts awarded to a president may be much more expensive than gifts awarded to a janitor.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to extend Jack to disclose providing remote redemption centers (applicant's thank-you gift dispatch agents) which are different from each other in accordance with the types of gifts. One of ordinary skill in the art at the time the invention was made would have been motivated to extend Jack to disclose providing

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remote redemption centers (applicant's thank-you gift dispatch agents) which are different from each other in accordance with the types of gifts for the obvious reason that redemption centers that offer gifts to janitors would likely be different from redemption centers that offer gifts to presidents and other officers and professionals.

By providing remote redemption centers (applicant's thank-you gift dispatch agents) which are different from each other in accordance with the types of gifts, it is possible to permit the president and other officers to feel better rewarded than persons of lesser prestige. Again, recipients may feel more appreciated and loved if they see that they could receive better-quality, more tasteful gifts, from more prestigious centers. Otherwise, the more prestigious persons may lose face with their friends.

**As per claim 12**, Jack discloses distributing catalogs of awards to customers ("...books of thank-you gifts..."). See, for example, at least Col. 6, lines 49-57. Jack discloses that catalogs to be distributed are different from each other in terms of one of prices of the gifts and price ranges of the gifts. See, for example, references to price ranges, at least Col. 5, line 1-Col. 7, line 17.

**As per claims 13, 14**, Jack discloses that the administrative center instruct redemption centers (applicant's thank-you gift dispatch agent) based on at least one of the names and numbers of said chosen gifts so that the chosen gifts are dispatched to the customers. Customers select their gifts based on at least one of the names and numbers of said gifts. See, for example, references to item number of a desired gift, Col. 11, lines 23-37. The administration center selects the gift from inventory (item 84) and processes the order (see at least Fig. 4, item 92). Redemption centers dispatch

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awards to customers. See, for example, Fig. 4 and related text, Col. 8, line 28-Col. 9, line 18. See also at least references to shipping of goods, for example, Col. 11, lines 37-53, Fig. 11, item 170, Fig. 4, item 94.


### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H Zurita whose telephone number is 703-605-4966. The examiner can normally be reached on 8a-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 703-308-3588. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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*JH*  
**James Zurita**  
**Patent Examiner**  
**Art Unit 3625**  
10 March 2004

  
**Jeffrey A. Smith**  
**Primary Examiner**